

REMARKS/ARGUMENTS

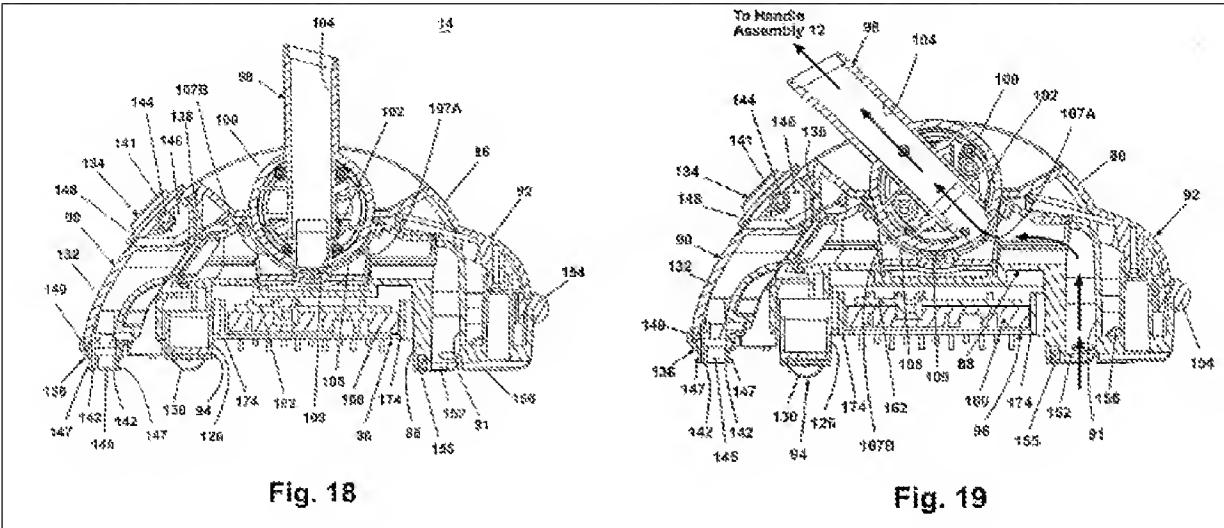
Claims 1-39 are pending in the application. Claims 1-20 were elected for prosecution in response to a restriction requirement, and claims 21-39 have been canceled without prejudice for protecting the subject matter thereof in a divisional patent application(s). Applicant notes correction of the claim descriptors for claims 2-20 from the previous Response filed November 5, 2008; claims 2-20 have not been amended during prosecution and are, therefore, now correctly labeled as “original” rather than “previously presented” as in the previous response.

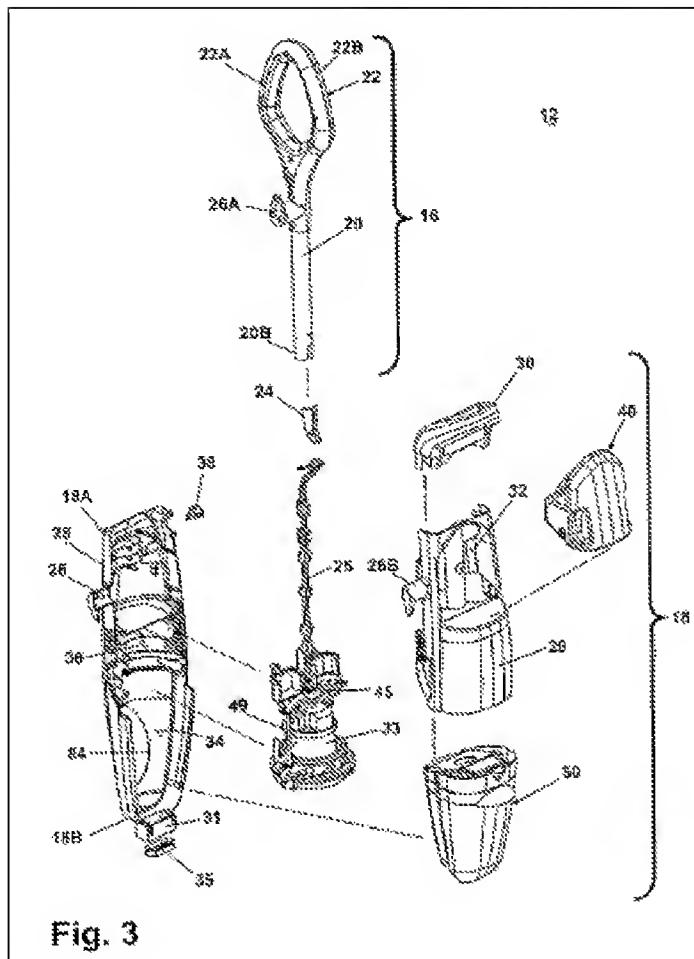
Claims 1-20 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. The rejection is respectfully traversed.

The Examiner avers that the specification fails to articulate the structure or elements that constitute the “actuator mounted to the handle and connected to the diverter,” as recited in claim 1, and, as a result, the claims contain subject matter which was not described in the specification in a such a way to enable one skilled in the art to which it pertains, or to which it is most nearly connected to make and/or use the invention.

Applicant points to paragraph [0089] and corresponding Figs. 19 and 20 of the application for disclosure of the actuator mounted to the handle and connected to the diverter:

“As the handle assembly 12 rotates, the handle pivot 98 also rotates and selectively prevents fluid communication between the recovery tank assembly 50 and one of the wet suction nozzle opening 145 and the dry suction nozzle opening 152. Thus, the **barrel 100** of the handle pivot 98 functions as a **diverter** valve that is **actuated** by pivoting the handle assembly 12. Further, the **conduit 104** of the handle pivot 98 not only defines part of the working air conduit, but it also **connects the handle assembly 12 with the barrel 100** so that movement of the handle assembly 12 translates into movement of the diverter valve.” (paragraph [0089], emphasis added)





wet suction position, which supports Applicant's position that the conduit 104/connector is an embodiment of the actuator mounted to the handle and connected to the diverter.

It follows that, contrary to the Examiner's assertion, the specification indeed articulates in the description of an exemplary embodiment the structure and elements that constitute the "actuator mounted to the handle and connected to the diverter" as recited in claim 1 and, thereby, provides an enabling disclosure of the claimed subject matter. The description provided in the specification, such as the text and figures identified above, enables one skilled in the pertinent art to make and use the invention of claim 1 and its dependent claims, including the "actuator mounted to the handle and connected to the diverter," without any, much less undue, experimentation. Because the specification provides an enabling description of the claim elements, Applicant respectfully requests withdrawal of the enablement rejection.

Applicant notes that while the Examiner has specifically identified in the Office Action the information that is allegedly missing (*i.e.*, the structure and elements that constitute the "actuator mounted to the handle and connected to the diverter," which Applicant has shown above is certainly *not* missing), the Examiner has not met the burden of providing a reason as to why one skilled in the art could not supply the information without undue experimentation (see MPEP § 2164.04 and § 2164.06(a)). No such reasons are provided in the Office Action.

Claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is respectfully traversed.

The Examiner states that the claims fail to provide any structure or limiting features that define what constitutes the "actuator." Applicant refers to the remarks provided above with respect to the rejection under the first paragraph of § 112 for a showing of the structure and elements (*i.e.*, the conduit 104) that constitute the "actuator" in the exemplary embodiment described in the specification. With respect to the use of "actuator" in the claims, Applicant construes from the statements in the Office Action that the Examiner considers the "actuator" a functional limitation without structure or limiting features.

There is nothing inherently wrong with defining a part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used (see MPEP § 2173.05(g)). The “actuator” limitation in claim 1 certainly conveys to a person of ordinary skill in the art that the claim element is one that actuates or induces movement of the diverter between the dry suction position and the wet suction position. An actuator is a well-known term used for an element that actuates or activates another element or device; that the claim does not specifically describe the structure that constitutes the “actuator” does not render the claim indefinite. Additionally, claim 1 does, in fact, provide some limiting features in that the “actuator” must be mounted to the handle and connected to the diverter and must perform the function of moving the diverter. As an actuator is well-known and claim 1 clearly specifies the particular function of the actuator along with some limiting structural features, one of ordinary skill in the art would appreciate the “actuator” of claim 1 and its dependent claims, especially in light of the description of the diverter actuator in the specification. Because the scope of the claims would be clear to one of ordinary skill in the art and clear as to what Applicant regards as the invention, Applicant respectfully requests withdrawal of the indefiniteness rejection.

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Examiner: David B. Thomas
Group Art Unit: 3723

If there are any outstanding issues which the Examiner feels may be resolved by way of telephone conference, the Examiner is cordially invited to contact the undersigned to resolve these issues. Early notification of allowability is respectfully requested.

Respectfully submitted,

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